

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKEMI EBINE

Appeal No. 98-2417
Application 08/570,894¹

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 11. Claims 12 through 20, the only other claims pending in the application, stand withdrawn from further consideration under 37 CFR § 1.142(b).

¹ Application for patent filed December 12, 1995.

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Appellant's invention is directed to a container for beverages and, more specifically, to a container having at least two compartments therein. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim, as reproduced from the Appendix to appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Rudick et al. (Rudick)	4,784,678	Nov. 15, 1988
Kim	5,492,244	Feb. 20, 1996
		(filed July 18, 1994)

Claims 1 through 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rudick.

Claims 2 through 11 stand additionally rejected under 35 U.S.C. § 103 as being unpatentable over Rudick.

Claim 11 stands further rejected under 35 U.S.C. § 103 as being unpatentable over Rudick in view of Kim.

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Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the final rejection (Paper No. 12, mailed June 20, 1997) and the examiner's answer (Paper No. 18, mailed March 19, 1998) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 17, filed February 19, 1998) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

As a preliminary matter, we observe that the review sought by appellant with regard to the first four issues enumerated on pages 5 and 6 of the brief, respectively

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regarding 1) the premature finality of the Office action mailed June 20, 1997, 2) the second restriction requirement imposed by the examiner, 3) the withdrawal of claims 12 through 14 from further consideration, and 4) the refusal of the examiner to consider the Supplemental Citation of Information (Paper No. 11), relates to subject matter which is reviewable by way of petition to the Commissioner and not by appeal to this Board. Contrary to appellant's apparent understanding, this Board does not exercise any general supervisory authority over the Examining Corps. Under 35 U.S.C. § 134 and 37 CFR § 1.191, appeals may be taken from the decision of the primary examiner to reject claims. Issues relating to an examiner's requirement for restriction, finality of a rejection, and the other issues mentioned above are reviewable by way of petition under 37 CFR § 1.181, not by appeal to this Board. See, e.g., In re Hengehold, 440 F.2d 1395, 1403, 169 USPQ 473, 479 (CCPA 1971).

Looking now to the examiner's prior art rejection of claims 1 through 11 under 35 U.S.C. § 102(b), we are in full

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agreement with the examiner's position as set forth on pages 4 and 5 of the answer regarding claims 1 through 10 on appeal, but we do not agree with the examiner's position on page 6 of the answer with respect to claim 11 on appeal.

An anticipation under 35 U.S.C. § 102(b) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Sys. Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). The law of anticipation does not require that the reference teach what the appellant is teaching or has disclosed, but only that the claim or claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Like the examiner, we find that Rudick discloses a beverage container or apparatus (Fig. 1) which comprises an outer body (11) providing a first compartment and an inner

body (14) providing a second compartment positioned internally within the first compartment. The space between the inner body/second compartment (14) and the outer body (11) of the apparatus defines a first enclosure within which liquid may be contained, while the second compartment (14) defines a second enclosure. The first compartment includes an openable liquid dispensing opening (at 19) which selectively permits access to the first enclosure, while the second compartment has an opening provided with an openable closure means (13) to selectively permit access into the second enclosure. As can be clearly seen in Figure 1 of Rudick, the second enclosure is not in communication with the first enclosure. Thus, we find that Rudick does disclose each and every element set forth in appellant's claim 1 on appeal. Moreover, it is our opinion that the apparatus of Rudick is fully capable of functioning in the manner set forth in the preamble of appellant's claim 1 "for containing a removable liquid and a removable product, article, prize, or object." In this regard, we observe that the first enclosure of Rudick does contain a liquid beverage therein, while the second enclosure clearly provides a space between the closure means (13) and the rolling diaphragm (18)

within which a product, article, prize, or object "may be removably contained." The recitation in claim 1 with respect to the apparatus being "for containing a removable liquid and a removable product, article, prize, or object," is merely a statement of purpose or intended use and is thus not effective to distinguish appellant's claimed apparatus/container from that of Rudick. See In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1074); In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); and In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). For the above reasons, the examiner's rejection of claim 1 on appeal will be sustained.

As to claim 2, we observe that when the closure means (13) is removed from the opening of the second compartment (14) in Rudick Figure 1, the second enclosure, at least in the area above the rolling diaphragm (18), will have "unobstructed communication with an atmosphere exterior to said apparatus without necessarily requiring opening of said liquid dispensing opening." In this regard, we note that claim 2 does not necessarily require that the entirety of the second enclosure must have "unobstructed communication with an

atmosphere exterior to said apparatus."

Regarding dependent claims 3 through 9, we note that appellant has indicated on page 7 of the brief that the claims on appeal "do not stand or fall together," however, we find no separate arguments in the brief addressing the limitations of claims 3 through 9. Accordingly, under 37 CFR § 1.192(c)(7) and (c)(8)(iii), we conclude that these claims in fact stand or fall with claims 1 and 2 from which they depend. Moreover, since we agree with the examiner that the elements of the apparatus set forth in claims 3 through 9 on appeal are found in the container of Rudick Figure 1, and appellant has not argued otherwise, it follows that we would sustain the rejection of these claims under 35 U.S.C. § 102(b) in any event.

Claim 10 on appeal sets forth that the rupturing or breaking means for permitting selective access to the first enclosure and opening of the liquid dispensing opening "comprises a pull tab," with the pull tab being pivotably secured to the planar flange of the second compartment that

forms the top of the container. As is apparent from Rudick, the container therein includes opening means (19) that utilizes a pull tab pivotably secured to the planar flange of the second compartment that forms the top of the container. The pivoting movement of the pull tab in Rudick is that expected of a conventional pull tab, wherein one end of the tab may be lifted upwardly and pivoted away from the top of the container, while the other end is pressed downwardly to force open the breakable seal that defines the openable liquid dispensing opening. Thus, we will sustain the examiner's rejection of claim 10 under 35 U.S.C. § 102(b) as being anticipated by Rudick.

We will not sustain the examiner's rejection of claim 11 under 35 U.S.C. § 102(b) as being anticipated by Rudick. Claim 11 addresses the capability of the pull tab to pivot between the position seen in Figure 3 of the drawings and the position seen in Figure 4 of the drawings. When positioned as in Figure 3, the pull tab closes or "at least partially obstructs" the opening to the second enclosure, while after being pivoted upwardly as in Figure 3 of the drawings, the

pull tab clearly does not obstruct the opening to the second enclosure. This pivoting movement of the pull tab thus permits selective access into the second enclosure. The examiner's position as explained on page 6 of the answer that, when in the horizontal position, the pull tab "can be pivoted to extend radially inwardly to obstruct the second opening," is based on total speculation and seems to mistake rotation of the pull tab in a horizontal plane for pivoting of the pull tab as discussed above, which it is not.

With regard to the examiner's rejection of claims 2 through 11 under 35 U.S.C. § 103 as being unpatentable over Rudick, we do not agree with the examiner that it would have been obvious to one of ordinary skill in the art to remove the diaphragm and the separator from the second compartment of Rudick, while retaining the second compartment for holding a removable product, prize or object, since such a modification of the reference would clearly destroy the Rudick reference for its intended purpose of providing a self-cooling container. While it is true that in In re Karlson, 311 F.2d 581, 584, 136 USPQ 184, 186 (CCPA 1963) the Court stated that

omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before,

we observe that the Court has also recognized that this is not a mechanical rule, and that such language in Karlson was not intended to short circuit the determination of obviousness mandated by 35 U.S.C. § 103. See In re Wright, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965). Thus, as in reviewing any obviousness determination, we must first look to the prior art and ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification proposed by the examiner. See, e.g., In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

In this particular case, we share appellant's view that the examiner's modification of Rudick in the specific manner posited in the final rejection and examiner's answer is based on the hindsight benefit of appellant's own teachings and not on anything fairly suggested by the reference itself.

Moreover, as we noted above, the critical nature of the diaphragm, separator, etc. within the second compartment of

Rudick to the invention in the Rudick patent clearly dictates against any such removal, and if the structure within the second compartment were removed, the very nature of the container therein would be altered to the extent that such container would not be capable of performing the same function as before. Thus, we will not sustain the examiner's rejection of claims 2 through 11 under 35 U.S.C. § 103 based on Rudick.

We will likewise not sustain the examiner's rejection of claim 11 under 35 U.S.C. § 103 as being unpatentable over Rudick in view of Kim. It is again our opinion that the examiner's modification of Rudick in the specific manner posited in the final rejection and examiner's answer is based on the hindsight benefit of appellant's own teachings and not on anything fairly suggested by the applied references.

In summary, only the decision of the examiner rejecting claims 1 through 10 under 35 U.S.C. § 102(b) as being anticipated by Rudick is affirmed. All the other rejections before us on appeal have been reversed. Thus, the decision of the examiner is affirmed-in-part.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
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APPENDIX

1. An apparatus for containing a removable liquid and a removable product, article, prize, or object, said apparatus comprising:

- (a) a first compartment defining a first enclosure within which the liquid may be contained or dispensed, said first compartment having an openable liquid dispensing opening which selectively permits access to said first enclosure; and
- (b) a second compartment defining a second enclosure within which the product, article, prize, or object may be

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removably contained, said second compartment being positioned internally within said first compartment, said second enclosure not communicating with said first enclosure, said second compartment having an opening which selectively permits access into said second enclosure.